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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,687	12/31/2003	Francis Joseph Kronzer	NPI-51 (19673)	2173
22827	7590	07/11/2006	EXAMINER	
DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449			CHAN, SING P	
			ART UNIT	PAPER NUMBER

1734

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/749,687

**Applicant(s)**

KRONZER, FRANCIS JOSEPH

**Examiner**

Sing P. Chan

**Art Unit**

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 65-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/15/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed June 5, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "For the flow-resistant layer, the melt flow index may be less than that of the peelable adhesive layer, such as by a factor of at least 10, desirably by a factor of at least 100, and most desirably by a factor of at least 1000."

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 83-85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's amendment of adding the melt index of the flow resistant layer to the Specification as well as the new claims are not supported by the specification as originally filed and therefore considered to be new matter.

Art Unit: 1734

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 65-107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 65, 100, and 104 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: forming the image onto the peelable transfer film.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 65-69, 71, 72, 74, 77-82, 86, 87, 89-92, and 95-103 are rejected under 35 U.S.C. 102(b) as being anticipated by Tada et al (U.S. 6,017,636)

Regarding claims 65, 91, 92, 96, and 100, Tada et al discloses a method of transferring an image to a substrate. The method includes providing a transfer sheet A with a release sheet and a layer of urethane emulsion resin (Col 4, lines 41-62) with acrylic emulsion added (Col 5, lines 19-35) and a transfer sheet B with a release sheet, and upper layer, an intermediate layer, and lower layer (Col 5, lines 52-55), forming an image layer on the transfer sheet B (Col 7, lines 32-39), adhering the two transfer

Art Unit: 1734

sheets together, peeling the release sheet from transfer sheet B, placing the layer exposed by peeling the release sheet onto the substrate, and transfer the laminate with heat and pressure to the substrate, and peeling the release sheet from transfer sheet A (Col 7, lines 10-25) with the image sheet between the transfer film of transfer sheet A and the substrate. Furthermore, the lower layer includes aromatic hydrocarbon to allow for accelerated softening to allow the layer to soften or melt to penetrate the inner surface of the object or substrate, i.e. melting before the intermediate layer melts, which has the same resin composition as the adhesive layer but without the aromatic hydrocarbon therefore, providing the intermediate layer as a flow resistant layer (Col 6, lines 40-64).

Regarding claims 66-69, Tada et al discloses the release sheet includes synthetic papers, plastic films, and papers (Col 4, lines 7-16), which papers are cellulosic material and is coated with an aqueous emulsion of acrylic-urethane resin on the back side of the sheet to prevent folds or curling (Col 4, lines 21-31), which would have no tack at a transfer temperature of 177°C to allow the papers to function as release sheet.

Regarding claims 71 and 72, Tada et al discloses the imaging receiver sheet is transferred by heat and pressure applied by either an iron or industrial high pressure press machine. (Col 7, lines 15-17 and Col 7, lines 40-48)

Regarding claims 74 and 101, Tada et al discloses the resin for the transfer sheet A or overlay transfer film includes the urethane emulsion has a softening point or melt at a temperature of 120°C or higher. (Col 4, lines 58-61)

Regarding claims 77, 78 and 102, Tada et al discloses the adhesive layer includes urethane and polyester resin, which have soften point or melting point of 120°C or higher. (Col 4, lines 58-61)

Regarding claims 79-82 and 103, Tada et al discloses the intermediate layer or flow resistant layer includes urethane and polyester resin (Col 6, lines 57-64), which are crosslinkable polymer and include crosslinking agent such as epoxy or isocyanate cross linking agent (Col 13, lines 39-43).

Regarding claim 86, Tada et al discloses the intermediate layer includes metal micro-powder, which is an opacifier. (Col 6, lines 65-66)

Regarding claim 87, Tada et al discloses upper layer is an image receptive layer, which overlies the intermediate layer or flow resistant layer. (Col 5, lines 52-55 and Col 6, lines 20-29)

Regarding claims 89 and 90, Tada et al discloses the upper layer has a thickness of 5-40  $\mu\text{m}$  (Col 6, lines 18-19), intermediate layer or flow resistant layer has a thickness of 5-40  $\mu\text{m}$  (Col 7, lines 3-4), and lower layer has a thickness of 5-20  $\mu\text{m}$  (Col 6, lines 52-53) for a total thickness of 15-100  $\mu\text{m}$ , which is 0.59 to 3.937 mils.

Regarding claim 95, Tada et al discloses the adhesive layer includes aromatic hydrocarbon, which is uncrosslinked. (Col 6, lines 40-49)

Regarding claim 97, Tada et al discloses the release support or paper includes a coating of talc and/or starch for sealing one or both side of the paper, which would function as a tie coat. (Col 4, lines 17-20)

Regarding claims 98 and 99, Tada et al discloses the transfer is performed at a temperature of 120 to 180°C. (Col 7, lines 10-25)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al (U.S. 6,017,636) as applied to claim 40 above, and further in view of Kronzer (U.S. 4,863,781).

Tada et al as disclosed above is silent as to the transfer sheet includes a conformable layer overlaying the base layer and underlaying the release layer. However, providing a conformable layer overlaying the base layer and underlaying the release layer is well known and conventional as shown for example by Kronzer. Kronzer discloses a melt transfer web. The web includes a conformable layer overlaying the base layer and underlaying the release layer (Col 5, lines 32-35)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a conformable layer overlaying the base layer and underlaying the release layer as disclosed by Kronzer in the method of Tada et al to allow the transfer film to contact uneven workpiece. (See Kronzer, Col 5, lines 28-31)

10. Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al (U.S. 6,017,636) as applied to claims 35, 55, and 60 above, and further in view of Saito et al (U.S. 6,043,194).

Tada et al discloses the transfer sheet A includes a layer of urethane emulsion resin (Col 4, line 58 to Col 5, line 7) and the transfer sheet B includes an upper layer of urethane resin (Col 6, lines 20-21) but is silent as to the protective overlay transfer film is formed of a different material than the imaged transfer film. However, providing a protective overlay transfer film formed of different material than urethane is well known and conventional as shown for example by Saito et al. Saito et al discloses a method of transferring a protective layer. The method includes providing a protective overlay film and transferring the film onto a print (Col 11, lines 22-26) with the film formed of aromatic polycarbonate (Col 5, lines 31-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an overlay protective transfer film formed of aromatic polycarbonate as disclosed by Saito et al in the method of Tada et al, which is a different material than the transfer sheet B layers to provide light fastness to the print and prevent fading of the dye constituting the image by light. (See Saito et al, Col 6, lines 61-66)

11. Claims 75, 76, and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al (U.S. 6,017,636) as applied to claims 35, 55, and 60 above, and further in view of Hare (U.S. 5,948,586).



Tada et al as disclosed above is silent as to the overlay film includes film forming binder of a powdered thermoplastic polymer and is an ink compatible layer. However, providing an overlay film with powdered thermoplastic polymer is well known and conventional as shown for example by Hare. Hare discloses a method of transferring an image to fabric. The method includes providing a transfer image receptor element with an image receptive film layer comprising a film-forming binder formed of powdered thermoplastic polymer, which melts in a range from 65°C to 180°C. (Col 12, lines 9-52)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a transfer image receptor element with an image receptive film layer comprising a film-forming binder formed of powdered thermoplastic polymer, which melts in a range from 65°C to 180°C as disclosed by Hare in the method of Tada et al to allow the transfer sheet to receive image from any printer such as color laser copier and/or printer and ink jet printers. (See Hare, Col 7, lines 16-27)

12. Claims 93 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al (U.S. 6,017,636).

Regarding claim 93, Tada et al as disclosed above is silent as to first separating the first base from the transfer layers, positioning the peeled transfer layer onto the substrate, and thereafter, positioning the second heat transfer sheet adjacent to the peeled transfer layers. However, a change of sequence of processing steps is a prima facie obvious in the absence of new or unexpected results. In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (See MPEP 2144.04 [R-1], section IV)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the layers and sheets in any order in the method of Tada et al, which is a prima facie obvious in the absence of new or unexpected results. (See MPEP 2144.04 [R-1], section IV)

Regarding claim 94, Tada et al discloses peeling the release form the second or sheet A from the urethane layer. (Col 7, lines 15-25)

13. Claims 104-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al (U.S. 6,017,636).

Regarding claim 104, Tada et al discloses a method of transferring an image to a substrate. The method includes providing a transfer sheet A with a release sheet and a layer of urethane emulsion resin (Col 4, lines 41-62) with acrylic emulsion added (Col 5, lines 19-35) and a transfer sheet B with a release sheet, and upper layer, an intermediate layer, and lower layer (Col 5, lines 52-55), forming an image layer on the transfer sheet B (Col 7, lines 32-39), adhering the two transfer sheets together, peeling the release sheet from transfer sheet B, placing the layer exposed by peeling the release sheet onto the substrate, and transfer the laminate with heat and pressure to the substrate, and peeling the release sheet from transfer sheet A (Col 7, lines 10-25) with the image sheet between the transfer film of transfer sheet A and the substrate. Furthermore, the lower layer includes aromatic hydrocarbon to allow for accelerated softening to allow the layer to soften or melt to penetrate the inner surface of the object or substrate, i.e. melting before the intermediate layer melts, which has the same resin composition as the adhesive layer but without the aromatic hydrocarbon therefore,

Art Unit: 1734

providing the intermediate layer as a flow resistant layer (Col 6, lines 40-64). Tada et al as disclosed above is silent as to first separating the first base from the transfer layers, positioning the peeled transfer layer onto the substrate, and thereafter, positioning the second heat transfer sheet adjacent to the peeled transfer layers. However, a change of sequence of processing steps is a prima facie obvious in the absence of new or unexpected results. In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (See MPEP 2144.04 [R-1], section IV)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the layers and sheets in any order in the method of Tada et al, which is a prima facie obvious in the absence of new or unexpected results. (See MPEP 2144.04 [R-1], section IV)

Regarding claim 105, Tada et al discloses the resin for the transfer sheet A or overlay transfer film includes the urethane emulsion has a softening point or melt at a temperature of 120°C or higher. (Col 4, lines 58-61)

Regarding claim 106, Tada et al discloses the adhesive layer includes urethane and polyester resin, which have soften point or melting point of 120°C or higher. (Col 4, lines 58-61)

Regarding claim 107, Tada et al discloses the intermediate layer or flow resistant layer includes urethane and polyester resin (Col 6, lines 57-64), which are crosslinkable polymer and include crosslinking agent such as epoxy or isocyanate cross linking agent (Col 13, lines 39-43).

***Response to Arguments***

14. Applicant's arguments filed June 5, 2006 have been fully considered but they are not persuasive.

15. In response to applicant's argument of Tada et al recites urethane emulsion layer 2 is preferably have a softening point of 140°C-220°C, but does not exclude other urethane emulsion with lower softening point, which Tada et al also recites using such as 120°C and higher. (See Col 4, lines 58-61)

16. In response to applicant's argument of transfer sheet's layers of Tada et al do not fuse or melt together, the examiner disagrees, since Tada et al does recite upper of the peelable transfer sheet is formed of urethane and the overlay layer of the second transfer is also formed of urethane would melt and fuse when they are laminated with a heated press at 120 °C to 180 °C. (Col 4, lines 58-60, Col 6, lines 20-21, and Col 7, lines 10-25) Furthermore, the claims as recited do not require the layers are fused or melt together.

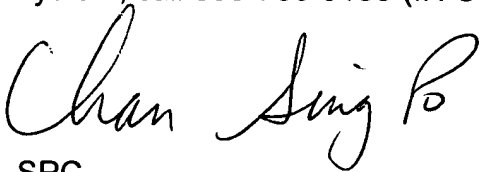
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone

Art Unit: 1734

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SPC



CHRIS FIORILLA  
SUPERVISORY PATENT EXAMINER

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